

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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YOON T. JEON and CHARLES GLUCHOWSKI  
Junior Party<sup>1</sup>

v.

THOMAS L. CUPPS and SOPHIE V. BOGDAN  
Senior Party<sup>2</sup>

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Patent Interference No. 104,241

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**FINAL DECISION AND SUMMARY JUDGMENT UNDER 37 C.F.R. § 1.617(g)**

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Before **CAROFF, METZ and HANLON**, Administrative Patent Judges

**METZ**, Administrative Patent Judge

On February 16, 2000, the parties, represented by their

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<sup>1</sup> Application 08/765,656, filed March 25, 1997. Accorded benefit of Application 08/285,956, filed August 4, 1994. Assignor to Synaptic Pharmaceutical Corporation.

<sup>2</sup> Patent 5,478,858, granted December 26, 1995, based on Application 08/349,558, filed December 8, 1994. Accorded the benefit of Application 08/169,868, filed December 17, 1993. Assignor to The Proctor & Gamble Company.

respective legal representatives, appeared at the final hearing requested by the junior party under 37 C.F.R. § 1.617(b).

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**THE PROCEEDINGS BELOW**

Jeon et al. filed their involved application on March 25, 1997. In the notice declaring this interference (Paper Number 1), Jeon et al. were accorded the benefit of their earlier filed U.S. application Serial Number 08/285,956, filed on August 4, 1994. Cupps et al. filed their involved application (which matured to U.S. Patent Number 5,478,858) on December 8, 1994.

In the notice declaring this interference, Cupps et al. were accorded benefit of their earlier filed U.S. application Serial Number 08/169,868, filed on December 17, 1993.

Therefore, Jeon et al. are the junior party and Cupps et al. are the senior party, respectively, in this interference. See 37 C.F.R. § 1.601(m).

Pursuant to 37 C.F.R. § 1.608(b), when the effective filing date of a junior party's involved application is more than three months after the effective filing date of the senior party's involved patent, the applicant must file evidence which demonstrates that they are prima facie entitled to judgment with respect to the patentee. The showing must

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also include an explanation stating with particularity the basis upon which applicant is prima facie entitled to judgment.

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Pursuant to 37 C.F.R. § 1.607, Jeon et al. requested that an interference be declared with Cupps et al. and made their presentation under 37 C.F.R. § 1.608(b) to the primary examiner on May 11, 1998 (see paper Number 10 in Jeon et al.'s involved application). The primary examiner, in the performance of his duties, determined that Jeon et al.'s showing alleged a basis upon which Jeon et al. would be entitled to judgment relative to Cupps et al. and forwarded the parties' respective involved application and patent and benefit applications to the Board of Patent Appeals and Interferences (the Board) for a determination by an examiner-in-chief<sup>3</sup> on the sufficiency of the showing and an ultimate determination of whether or not the interference should go forward.

In Paper Number 2 of this proceeding, the APJ, in the performance of his interlocutory duties, determined that Jeon et al.'s showing under 37 C.F.R. § 1.608(b) failed to show that Jeon et al. were prima facie entitled to judgment

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<sup>3</sup> Examiners-in-chief (35 U.S.C. §§ 3 and 7) are also known as Administrative Patent Judges (APJ's). See the Commissioner's Notice dated October 15, 1993, appearing in 1156 O.G. 32, November 9, 1993.

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relative to the senior party patentees, Cupps et al. After setting forth his analysis of Jeon et al.'s showing and explaining why he found the showing to be inadequate, the APJ placed Jeon et al. under an

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order to show cause why judgment should not be entered against them pursuant to 37 C.F.R. § 1.617(a).

Jeon et al. responded to the order to show cause by filing the following papers:

**"RESPONSE OF JUNIOR PARTY JEON TO NOVEMBER 20, 1998 ORDER TO SHOW CAUSE"** (c.o.m. December 21, 1998 - Paper Number 3); and,

**"JUNIOR PARTY JEON PRELIMINARY MOTION NO. 1"** (c.o.m. December 21, 1998 - Paper Number 4)

In their response to the order to show cause, Jeon et al., inter alia: requested a final hearing to review the decision of the APJ as set forth in the order to show cause; explained why judgment should not be entered against Jeon et al; submitted additional evidence accompanied by an explanation of "good cause" for proffering the additional evidence; and, filed a motion under 37 C.F.R. § 1.633(g) attacking the benefit accorded Cupps et al. in the notice declaring this interference.

After the above-noted papers were filed, in an order mailed on March 9, 1999 (Paper Number 5), the APJ provided the senior party an opportunity to file an opposition to Jeon et al.'s motion and also an opportunity to file their views on

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why summary judgment against the junior party was proper. Further, the APJ provided Jeon et al. an opportunity to reply to any papers filed by Cupps et al. See, generally, Paper Number 5.

In response to the APJ's order, the following papers were filed in this proceeding:

**"SENIOR PARTY CUPPS AND BOGDAN STATEMENT UNDER 37 C.F.R. 1.617(d)",** filed on April 6, 1999 (c.o.m. April 1, 1999 - Paper Number 6);

**"SENIOR PARTY CUPPS AND BOGDAN OPPOSITION NO. 1",** filed on April 6, 1999 (c.o.m. April 1, 1999 - Paper Number 7);

**"REPLY OF PARTY JEON TO SENIOR PARTY CUPPS AND BOGDAN OPPOSITION NO. 1",** filed on April 20, 1999 (c.o.m. April 16, 1999 - Paper Number 8);

**"REPLY OF JUNIOR PARTY JEON UNDER 37 C.F.R. § 1.617(e) TO SENIOR PARTY CUPPS AND BOGDAN'S STATEMENT UNDER 37 C.F.R. § 1.617(d)",** filed on April 20, 1999 (c.o.m. April 16, 1999 - Paper Number 9);

#### ISSUES

The issues presented to this merits panel of the Board are: (1) was the order to show cause issued by the APJ in Paper Number 2 properly issued; (2) should the additional evidence furnished by the party Jeon et al. subsequent to the



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order to show cause be considered by this merits panel; (3) if the additional evidence is considered, have Jeon et al. made out a case of prima facie entitlement to judgment relative to Cupps et al.; and, (4) should the Jeon et al. motion filed under 37 C.F.R. § 1.633(g) and seeking to deny the senior party Cupps et al. the benefit accorded them for their earlier filed application be granted.

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After a thorough review of the entire record before us and for reasons fully expressed below, we find that the order to show cause was properly issued by the APJ in the discharge of his interlocutory duties. We find that Jeon et al. have failed to establish "good cause" for now presenting the additional evidence filed by them in support of their showing under 37 C.F.R. § 1.608(b). We also find that Jeon et al. have failed to meet their burden of persuasion and have failed to establish that they are entitled to the relief requested by them in their motion under 37 C.F.R. § 1.633(g).

**THE MOTION UNDER 37 C.F.R. § 1.633(g)**

In partial response to the order to show cause, Jeon et al. filed a motion under 37 C.F.R. § 1.633(g), attacking the benefit accorded Cupps et al. for their earlier filed U.S. application Serial Number 08/169,868, filed on December 17, 1993. If Jeon et al. meet their burden of persuasion and establish that Cupps et al. are not entitled to the date for which they have been accorded benefit then Cupps et al. effective filing date would become the filing date of their involved patent, that is, December 8, 1994, and Cupps et al.

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would become the junior party. As correctly noted by Jeon et al., if Cupps et al. becomes the junior party then no showing by Jeon et al. under 37 C.F.R. § 1.608(b) would have been necessary to go forward in this interference. Accordingly, we shall first determine if Jeon et al.'s motion should be granted.

A party bringing a preliminary motion in an interference bears the burden of establishing that the party is entitled to the relief sought in the motion. Kubota v. Shibuya, 999 F.2d 517, 520-21, 27 USPQ2d 1418, 1422 (Fed. Cir. 1993); 37 C.F.R. § 1.637(a), first sentence. Pursuant to 37 C.F.R. § 1.637(g), the motion "shall explain, as to each count, why an opponent should not be accorded the benefit of the filing date of the earlier application."

According to Jeon et al.'s motion, Cupps et al. should not have been accorded benefit of their earlier filed U.S. application with respect to the count in this interference.<sup>4</sup> Jeon et al. observes that the count recites that **R'** may be a cyano (**-C=N**) group and the description of "cyano" substituents in the disclosure of Cupps et al.'s involved application was

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<sup>4</sup> A copy of the count is attached in the appendix to this decision.

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added, for the first time, when the Cupps et al. involved patent, a continuation-in-part of Cupps et al. benefit application, was filed on December 8, 1994. Thus, Jeon et al. urge that because Cupps et al.'s benefit application does not disclose "cyano" substituents and because "cyano" substituents are required by the

count, Cupps et al. should not have been accorded benefit of their earlier filed application. We disagree.

Jeon et al.'s position evidences a fundamental misunderstanding of the law and confuses benefit accorded with respect to a count with the question of benefit under 35 U.S.C. §§ 119 and 120. Benefit of prior applications for priority purposes is accorded with respect to counts not claims. Daniels v. Daum, 214 USPQ 911, 917 (Bd. Pat. Int. 1982). All that is necessary for a party to be entitled to benefit of an earlier filed application for priority purposes is compliance with 35 U.S.C. § 112 with respect to at least one embodiment within the scope of the count. Hunt v. Treppschuh, 532 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975); Den Beste v. Martin, 252 F.2d 302, 304, 305, 116 USPQ 584, 586 (CCPA 1958); Mori v. Costain, 214 USPQ 295, 297 (BPAI 1982); MPEP § 2309.02.

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Benefit of prior applications under 35 U.S.C. § 119 and 35 U.S.C. § 120 for determining what is the effective date of an application under 35 U.S.C. § 102(e) is accorded with respect to what is claimed by an applicant. That is, under 35 U.S.C. §§ 119 and 120 the question to be resolved is: does an applicant's disclosure in the specification of the benefit application relied on satisfy the requirements of 35 U.S.C. § 112, first paragraph, with respect to the full scope of the subject matter now being claimed by applicant. With respect to 35 U.S.C. § 119, see In re Gostelli, 872 F.2d 1008, 1010, 1011, 10 USPQ2d 1614 (Fed. Cir. 1989); Kawai v. Metlesics, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973). With respect to 35 U.S.C. § 120, see In re Lukach, 442 F.2d 967, 969, 970, 169 USPQ 795, 796 (CCPA 1971); In re Scheiber, 587 F.2d 59, 62, 199 USPQ 782, 784 (CCPA 1978).

We find that Jeon et al. have failed to meet their burden of persuasion and have failed to prove that they are entitled to the relief sought by them in their motion. Rather than prove that the Cupps et al. benefit application does not describe and enable, in the sense of 35 U.S.C. § 112, at least one species within the count, Jeon et al. have improperly focused on whether or not Cupps et al. benefit application supports, in the sense of 35 U.S.C. § 112, the full scope of

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Cupps et al.'s claims in their involved application.

Moreover, because Jeon et al. is the party bearing the burden of persuasion it was not necessary for Cupps et al. to prove that they are, in fact, entitled to the benefit of their earlier filed application. Nevertheless, we agree with Cupps et al., for reasons expressed in their opposition to the Jeon et al. motion that because their benefit application, of which their involved application is a continuation-in-part, describes at least one embodiment within the count in a manner which satisfies the requirements of 35 U.S.C. § 112, that Cupps et al. were properly accorded benefit of their earlier filed application in the declaration of this interference.

Finally, we have not overlooked Jeon et al.'s collateral attack on the quality of the Cupps et al. disclosure vis-à-vis Jeon et al.'s burden of proof in presenting their showing under 37 C.F.R. § 1.608(b) but find that Jeon et al.'s attack, like Jeon et al.'s arguments in favor of granting their motion, is founded on a misunderstanding of the relevant law. Simply stated, Jeon et al. have confused the requirements for prima facie proving an actual reduction to practice (Jeon et

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al.'s burden) with the requirements for what constitutes a constructive reduction to practice. Suffice it to say that Cupps et al. are the senior party in this interference because their benefit application serves as a constructive reduction to practice of the subject matter defined by the count. See Kawai v. Metlesics, 480 F.2d at 886, 178 USPQ at 163.

Accordingly, for all the above reasons, the motion under 37 C.F.R. § 1.633(g) is **DENIED**. Because Jeon et al.'s motion has been denied, we must now determine whether or not the order to show cause was properly issued by the APJ.

**THE ORDER TO SHOW CAUSE**

As the party with the burden of persuasion under 37 C.F.R.

§ 1.608(b), Jeon et al. had the burden to establish that they were prima facie entitled to judgment relative to Cupps et al. In order to establish they were prima facie entitled to judgment, Jeon et al. was required to prove at least so much of their case as would entitle them to an award of priority assuming that Cupps et al. relied solely on their filing date and were not to rebut any of Jeon et al.'s case. See Hahn v. Wong, 892 F.2d 1028, 1032, 13 USPQ2d 1313, 1317 (Fed. Cir

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1989).

Jeon et al. elected to prove they were prima facie entitled to judgment by attempting to prove that they actually reduced to practice an embodiment within the count prior to Cupps et al.'s effective filing date. See page 4 of Paper Number 10 of Jeon et al.'s involved application ("**REQUEST FOR INTERFERENCE UNDER 37 C.F.R. §1.607 AND SHOWING UNDER 37 C.F.R. §1.608(b)**").

The count in this interference is a so-called bifurcated count, that is, the count defines the interfering subject matter in four alternatives, each of which is presumed to be the "same patentable invention" in the sense of 37 C.F.R. § 1.601(n). Thus, the count requires: either of two compounds represented by a particular structural formula; a pharmaceutical composition comprising a safe and effective amount of a compound of either aforementioned formula; or, a method for preventing or treating various diseases comprising administering a safe and effective amount of a compound of either formula.

Thus, the evidence relied on by Jeon et al. in their showing under the rule must establish that every limitation of



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the count in the interference existed in the embodiment relied on as an actual reduction to practice and the embodiment must be demonstrated to have performed as intended. Newkirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987); Correge v. Murphy, 705 F.2d 1326, 1329, 217 USPQ 753, 755 (Fed. Cir. 1983); Parker v. Frilette, 462 F.2d 544, 548, 174 USPQ 321, 325 (CCPA 1972); Szekely v. Metcalf, 455 F.2d 1393, 1396, 173 USPQ 116, 119 (CCPA 1972); Schur v. Muller, 372 F.2d 546, 551, 152 USPQ 605, 609 (CCPA 1967). The invention of a compound is not considered to be complete unless its utility is established by proper tests. Blicke v. Treves, 241 F.2d 718, 720, 112 USPQ 472, 475 (CCPA 1957).

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Additionally, in establishing an actual reduction to practice, each of the prerequisites for establishing an actual reduction to practice must be corroborated by a non-inventor. The objective sought in requiring independent corroboration of an actual reduction to practice of a chemical compound is to insure that the inventor actually prepared the compound and knew it would work for its intended purpose. However, the standard is not inflexible and is not to be applied mechanically. Hence a "rule of reason" approach is required. Mikus v. Wachtel, 504 F.2d 1150, 1152, 183 USPQ 752, 753 (CCPA 1974). Further, corroboration does not necessarily have to be established by an "over-the-shoulder" observer. Rather, sufficient circumstantial evidence can satisfy the requirement for corroboration. Knorr v. Pearson, 671 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982); Lacotte v. Thomas, 758 F.2d 611, 613, 225 USPQ 633, 634 (Fed. Cir. 1985); Berges v. Gottstein, 618 F.2d 771, 774, 205 USPQ 691, 695 (CCPA 1980). Nonetheless, each and every limitation or element of the count must be corroborated. Mikus v. Wachtel, id.

Where, as here, the count embraces a broad genus of compounds, the reduction to practice of a single compound

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within the genus of compounds defined by the count constitutes a reduction to practice of the invention defined by the count for purposes of priority of invention in an interference proceeding. Breuer v. DeMarinis, 558 F.2d 22, 24, f.n. 5, 194 USPQ 308, 309, f.n. 5 (CCPA 1977); Mikus v. Wachtel, 504 F.2d at 1152, 183 USPQ at 753; Den Beste v. Martin, supra.

Accordingly, in order to prove they were prima facie entitled to judgment relative to Cupps et al. based on an actual reduction to practice before Cupps et al. effective filing date, Jeon et al. were required to prove that they: (1) actually prepared any single compound within the scope of the count (or a pharmaceutical composition comprising a safe and effective amount of a compound within the scope of the count or a method for preventing or treating various diseases comprising administering a safe and effective amount of a compound within the count): (2) appreciated that the compound prepared by them was the compound they sought to prepare; and (3) adequately tested the compound prepared to establish that the compound possessed a practical utility.

In their submission under 37 C.F.R. § 1.608(b) filed with the primary examiner, Jeon et al. attempted to prove that Yoon

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T. Jeon, one of the named inventors in Jeon et al.'s involved application, actually reduced to practice an embodiment within the count on a date prior to Cupps et al.'s December 17, 1993, effective filing date. Specifically, Jeon et al. assert that Yoon T. Jeon synthesized the compound of claim 29 of their involved application as evidenced by a page from Jeon's laboratory notebook. See **Exhibit B** to Paper Number 10 and **Exhibit 1** to **Exhibit B**. The alleged actual synthesis of the compound of Jeon et al.'s claim 29 is urged to have been corroborated by Murali Dhar's declaration (**Exhibit C**) wherein Dhar declared that it is his signature on the bottom of Jeon's notebook page under the heading "Witnessed and Understood by me". Dhar also declared to have observed the synthesis of the compound as set forth by Jeon in Jeon's notebook and that the date the compound was synthesized was "prior to December 17, 1993".

The APJ held that even assuming, arguendo, that Jeon et al.'s showing proved that a compound within the count was synthesized prior to December 17, 1993, there was no evidence submitted with Jeon et al.'s showing under 37 C.F.R. § 1.608(b) which established any utility for the compound

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alleged to have been synthesized by Jeon. Nevertheless, the APJ also held that neither the notebook page on which Jeon et al. rely nor Jeon's declaration considered with Dhar's corroborating declaration establish a structure for whatever compound was actually synthesized by Jeon let alone a compound having the structure depicted on Jeon's laboratory notebook page. The APJ found that Jeon et al.'s showing lacked at least evidence of any recognition by the inventor contemporaneous in time with the alleged synthesis which proved that a compound actually possessing the structure depicted on the notebook page was actually synthesized on a date prior to Cupps et al. effective filing date.

Jeon et al. have argued that the APJ's determinations should be overturned, that we should find the original showing under 37 C.F.R § 1.608(b) adequate to establish Jeon et al. are prima facie entitled to judgment relative to Cupps et al., that the order to show cause should be vacated for reasons set forth on pages 6 through 10 of Paper Number 3 and, the interference should be permitted to go forward.

We agree with the APJ's conclusion that Jeon et al.'s original submission failed to establish any utility for the

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compound allegedly synthesized by Jeon. Mere inspection of the evidence originally submitted by Jeon et al. under 37 C.F.R.

§ 1.608(b) evidences a total lack of any reference whatsoever to any evidence of a practical utility contemporaneous in time with the evidence relied on to establish an actual reduction to practice. On that basis alone, we find the APJ correctly issued the order to show cause.

The error we see in Jeon et al.'s arguments as set forth in Paper Number 3 on pages 6 through 10 concerning: the known utility of similar "ligands"; structural similarity to other compounds having known utility; Jeon's expectation that the compound he prepared would have a particular utility; and, allegedly known non-pharmaceutical uses of the compound allegedly prepared by Jeon is that Jeon et al.'s original submission contains no evidence in support of these mere arguments and certainly no evidence contemporaneous in time with the alleged synthesis which established an appreciation by the inventor of such alleged utility. Mere attorney argument cannot take the place of objective, probative evidence lacking in the record. Knorr v. Pearson, 671 F.2d

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1368, 1373, 213 USPQ 196, 200 (CCPA 1982).

Additionally, Jeon et al.'s argument that "numerous compounds within the general class of two or three ring compounds attached to a 2-imidazolinylamino moiety, such as the compound of claim 29 and of the count, were known to be ligands for an "α<sub>2</sub> adrenergic receptor" (page 6 of Paper Number 3) simply ignores the fact that Jeon et al.'s original showing contained no evidence of any utility. There is certainly no evidence in the original showing which establishes that at the time Jeon allegedly synthesized a compound within the count that the compound allegedly synthesized was known to be member of a family of known compounds which possessed a common utility. Jeon et al.'s pronouncement that Jeon synthesized the compound set forth in his laboratory notebook "with the certain expectation that the compound would have this utility" lacks any support in the record evidence and is considered to be mere attorney argument. We also direct Jeon et al.'s attention to our reviewing court's decision in Fujikawa v. Wattanasin, 93 F.3d 1559, 39 USPQ2d 1895 (Fed. Cir. 1996). In addition to affirming the requirement for a showing of practical utility in establishing an actual reduction to

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practice, at 93 F.3d 1564, 39 USPQ2d 1899 the court noted in a discussion of the necessity for testing that:

[i]t may be difficult to predict, however, whether a novel compound will exhibit pharmacological activity, even when the behavior of analogous compounds is known to those skilled in the art. Consequently, testing is often required to establish practical utility.

Contrary to Jeon et al.'s representation at page 8 of Paper Number 3, the Cupps et al. patent involved in this interference does not acknowledge at column 1, lines 9 through 15 that one or two ring 2-imidazolinylamino compounds are known as a family to possess "<sub>2</sub> adrenergic receptors. Rather, the reference therein is directed to Cupps et al. particular compounds as described by the formula at column 2, lines 24 through 49. Further, while the Cupps et al. patent does discuss from column 1, lines 17 through 57 numerous references to various compounds generically described as " adrenergic receptors, the most significant disclosure in Cupps et al. in column 1 may be found in lines 57 through 61 wherein it is disclosed that:

However, many compounds related in structure to those of the subject invention do not provide the activity and specificity desirable when treating respiratory, ocular or gastrointestinal disorders. (emphasis added)



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Thus, based on this record, the absence of any evidence in Jeon et al.'s original showing establishing that there exist "analogous compounds" known by persons skilled in the art to possess "pharmacological activity" was an adequate basis for requiring evidence of testing the compound allegedly synthesized in order to establish the compound possessed practical utility.

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Jeon et al.'s entreaty that we go to Table 1 in the specification of their involved application for evidence of a correlation between structure and pharmacological activity evidences a misunderstanding of Jeon et al.'s burden of persuasion. Jeon et al. were required to establish that at a time prior to Cupps et al.'s effective filing date they prepared a compound within the count and recognized a practical utility for the compound. Manifestly, because Jeon et al.'s application was filed after Cupps et al.'s effective filing date, it cannot evidence a recognized practical utility for their claimed compound before Cupps et al.'s effective filing date.

We also agree with the APJ's finding below that the copy of a page from Jeon's laboratory notebook which outlines a proposed reaction scheme and which depicts a final product as described by a structural formula coupled with the notation on the notebook page that a reaction mixture was obtained was insufficient to establish that a compound within the count was actually prepared. Reduction to practice of a compound requires, inter alia: (1) production of a compound satisfying every limitation of the count; (2) recognition that a compound

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within the count was actually produced; and, (3) recognition of a specific practical utility for the compound. See, Rivise and Caesar, Interference Law and Practice § 132 at page 396 (1948).

We find that the notebook page, considered with Jeon's declaration and Dhar's corroborating declaration at best establish that Jeon conceived of a method for preparing a compound of the indicated formula. Jeon et al. specifically recognize this fact (see page 6 of Paper Number 3). However, Jeon et al. have neither relied on a conception plus reasonable diligence theory nor presented any evidence of reasonable diligence from a time just prior to Cupps et al.'s effective filing date up to a reduction to practice by Jeon et al. Evidence of prior conception alone would not prima facie entitle Jeon et al. to judgment relative to Cupps et al.

Further, the mere description of a reaction scheme and a proposed product of that scheme does not in and of itself lead to the conclusion that a compound having the structure depicted on the laboratory notebook page was actually synthesized. The fact that the notebook page bears the initials under "Witnessed & Understood by me" of Murali Dhar

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does not establish the identity of what compound was actually produced by Jeon or independently corroborate the statements made on Jeon's notebook page but only serves to establish that the notebook page existed on a certain date, allegedly prior to December 17, 1993. Hahn v. Wong, 892 F.2d at 1032, 13 USPQ2d at 1317.

In reaching this conclusion, we have not overlooked Jeon et al.'s argument that the "representation of a Thin Layer Chromatography ("TLC") result represented by the rectangle on the left-hand side of the page) which was performed immediately after the synthesis scheme" proves a pure product was obtained (page 2 of Yoon T. Jeon's declaration filed as part of Paper Number 3 in this interference). Neither have we overlooked the fact that in Dhar's declaration Dhar has declared that:

I observed the synthesis of the compound by Yoon T. Jeon. The date on which the synthesis took place is prior to December 17, 1993, although the date has been redacted from the copy of the notebook page.

Nonetheless, the "representation of a Thin Layer Chromatography" on the laboratory notebook page does not identify the structure for the pure product allegedly obtained.

Indeed, TLC cannot establish the identity of the compound synthesized because TLC does not possess that qualitative capability for a single, unknown compound<sup>5</sup>. Moreover, absent any additional evidence in their original submission which confirms the identity of what compound was actually synthesized by Jeon, Dhar could not have known what the identity of the reaction product obtained by Jeon was or identified its structure based solely on his mere visual observation let alone that the reaction produced a compound having the formula depicted on the notebook page. Suffice it to say that the notebook itself lacks any evidence indicative of a contemporaneous in time recognition by either Jeon or Dhar of the identity of the compound Jeon actually synthesized.

Jeon et al.'s argument that their original showing "did not need to be under 37 C.F.R. § 1.608(b) because the count had not yet been defined" (page 4 of Paper Number 3) ignores

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<sup>5</sup> While Cupps et al. refer to Jeon et al.'s "representation" of a TLC plate as a "photo", Jeon et al. merely describes it as a "representation". From the page reproduced from the notebook it appears to this Board that the representation is merely a sketch. Nevertheless, whether a "photo" or a sketch, TLC is not a qualitative tool unless an unknown product and a known sample of a desired product are eluted on the same plate.

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the facts

in the record. Specifically, Jeon et al. requested that, pursuant to 37 C.F.R. § 1.607, an interference be declared with Cupps et al. (see Paper Number 10). The very rule under which Jeon et al. requested an interference requires that the party requesting the interference present a proposed count, present at least one claim in their involved application corresponding to the count and identify at least one claim in the patent with whom the party seeks an interference which corresponds to the count. See 37 C.F.R. § 1.607(a).

It is clear from a review of Jeon et al.'s original submission that Jeon et al. intended to file and actually filed their showing under 37 C.F.R. § 1.608(b), not 37 C.F.R. § 1.608(a) as argued by Jeon et al. It is also clear that, contrary to Jeon et al.'s argument that they did not know what the count in the interference would be, Jeon et al. proposed a count in their original showing, as required by the rule, which proposed count was identical to Jeon et al.'s claim 29. Claim 14 of Cupps et al. patent was said by Jeon et al. in their original showing to correspond exactly to the count proposed by them.

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In total, Jeon et al.'s evidence presented under 37 C.F.R.

§ 1.608(b) and considered by the APJ simply lacks sufficient evidence of additional surrounding facts and circumstances, both known by the inventor and independent thereof, which establishes both a utility for the compound allegedly synthesized and an appreciation of or recognition by Jeon at the time of the alleged synthesis that he actually prepared the compound depicted in his notebook. Accordingly, we find that the APJ properly found Jeon et al.'s original showing to be inadequate under the rule. We also find that the APJ properly placed Jeon et al. under an order to show cause pursuant to 37 C.F.R. § 1.617(a), third sentence.

**JEON ET AL.'S SUPPLEMENTAL EVIDENCE**

Jeon et al. responded to the order to show cause by, inter alia, filing additional evidence addressing the shortcomings found by the APJ with respect to Jeon et al.'s original showing and which Jeon et al. urge establishes: (1) a compound within the count was, in fact, prepared before Cupps et al. effective filling date; and, (2) the compound prepared had utility. Jeon et al. have also made a showing which they

allege establishes "good cause" why the additional evidence was not earlier presented with the original submission. For reasons which follow, we find: (1) Jeon et al. have failed to establish "good cause" for not earlier presenting the additional evidence filed in response to the order to show cause; and, (2) assuming for the sake of argument that "good cause" had been shown, the evidence neither establishes that a compound within the count was prepared nor that the compound prepared was recognized at the time of synthesis to have practical utility.

Jeon et al. urge that "good cause" exists for their supplemental submission of evidence because: (1) on this record they have presented more evidence of utility than the senior party presented in their application which matured to their patent involved in this interference and that we should consider said supplemental evidence because "[e]quity between the parties mandates such a result." (page 12 of Paper Number 3); (2) after reviewing Jeon et al.'s submission under 37 C.F.R § 1.608(b), the examiner determined that an interference should be declared; and, (3) Jeon et al. relied on the examiner's implicit finding of utility and the APJ should have



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deferred to the examiner's implicit finding on which Jeon et al. relied.

Jeon et al.'s argument that equity between the parties mandates that we consider their supplemental showing simply misunderstands the procedure under 37 C.F.R. § 1.608(b) and is also unsupported by any legal precedent which supports Jeon et al.'s position. Cupps et al. is simply not under any burden of persuasion at this point in this proceeding. Jeon et al. are under the burden of showing that they are entitled to go forward in this proceeding based on their originally filed showing under 37 C.F.R. § 1.608(b) or their originally filed showing in further view of their supplemental evidence. Further, the requirements for proving an actual reduction to practice are separate and distinct from the requirements for satisfying 35 U.S.C. §§ 101 and 112 with respect to the utility requirements for an application for a patent. Suffice it to say that the sufficiency of Cupps et al.'s disclosed utility for their compounds in the disclosure of their involved patent is simply not relevant to Jeon et al.'s showing under the rule or Jeon et al.'s burden of persuasion.

With respect to Jeon et al.'s second and third reasons

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for accepting their supplemental evidence, we simply note that Jeon et al.'s arguments and underlying reasoning simply do not represent the relevant law. In the first instance, Jeon et al. misunderstand the role of the primary examiner in reviewing the original showing under 37 C.F.R. § 1.608(b). When a showing under 37 C.F.R. § 1.608(b) is required before declaring an interference, the initial review of the showing is performed by the primary examiner. The primary examiner's review is solely to ensure that a basis for judgment is alleged and to ensure the requisite parts required by the rule are submitted. Subsequently, assuming the primary examiner determines the filing requirements of 37 C.F.R. § 1.608(b) have been fulfilled, it is the APJ, in the exercise of his interlocutory authority, who rules on the adequacy of the showing. See Hahn v. Wong, 892 F.2d at 1035, 13 USPQ2d at 1319 wherein the court noted that:

the sole role of the primary examiner was to determine whether Hahn alleged a basis for priority over Wong, not to determine whether Hahn had made a *prima facie* showing of such priority. 37 C.F.R. §1.608(b). *Cf.* M.P.E.P. §2308.02, last paragraph. Only the examiner-in-chief could make the latter determination and decide whether the interference should go forward.

See also M.P.E.P. § 2308.02, pages 2300-21 and 2300-22. If

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the showing is found by the APJ to be adequate to make out a prima facie case of entitlement to judgment, then and only then is an interference declared and allowed to proceed as any other ordinary interference. Thus, Jeon et al.'s reliance on both the examiner's alleged determination that an interference be declared and the examiner's alleged "implicit" finding of utility was misplaced.

Moreover, the question before us is not whether or not Jeon et al.'s compounds embraced by their sole claim corresponding to

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the count actually possess a practical utility. The question before us is whether or not Jeon et al.'s showing proves that Jeon et al. appreciated or recognized a utility for a compound within the count at a date before Cupps et al.'s effective filing date.

We also agree with Cupps et al. that Jeon et al. have simply failed to establish why the evidence now presented by them was not earlier presented. Specifically, Jeon et al. have failed to establish that the newly presented evidence was not available to them when their original showing was proffered. Indeed, Jeon's declaration filed with the supplemental evidence alleges that the NMR and Mass Spectrometry data submitted as Exhibits 1, 2 and 3 were performed before Cupps et al.'s effective filing date. Therefore, there is no valid reason for why such evidence was not included with Jeon et al.'s original showing. The same can be said for Jeon et al.'s supplemental evidence of practical utility for the compound allegedly synthesized by Jeon as represented by Exhibits 6, 7 and 8 of the supplemental showing.

Contrary to Jeon et al.'s argument that we should

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consider the supplemental evidence proffered by them because "the Judge may now require more evidence," (page 12 of Paper Number 3) it was the law, not the APJ, which required more evidence than provided by Jeon et al. with their original showing. Jeon et al. were presumed to know the legal requirements for establishing an actual reduction to practice when their original showing was made. To the extent that Jeon et al.'s argument is in reality an argument that they were unaware of the legal requirements for proving an actual reduction to practice, the commentary to the new rules and the cases interpreting the new rules make it clear ignorance of the substantive requirements of the law does constitute "good cause" under the rule.

Although we have held that Jeon et al. have failed to establish "good cause" for now presenting their supplemental evidence and, therefore, we need not consider their evidence on the merits, in an abundance of caution and for the completeness of the record we make the following observations. In the first instance, all the supplemental evidence is proffered by Yoon T. Jeon, one of the named inventors in Jeon et al.'s involved application and, accordingly, requires

corroboration by a non-inventor. There is no evidence of corroboration accompanying Jeon et al.'s supplemental showing. Additionally, while an NMR spectrum may be consistent with a hypothetical structure for a given unknown compound it cannot without more, ordinarily, prove an unknown compound possesses a particular structure. Further, when the handwritten formula on the face of Exhibit 1 was written on the exhibit or by whom is not set forth. We also have no way of determining from Jeon's declaration who performed the analysis described in Exhibits 1, 2, 3, 6, 7 and 8 nor is there any evidence, independent of the inventor, establishing that the compound described in Jeon's notebook was the compound for which the analysis was performed.

Jeon et al.'s additional evidence which allegedly establishes that the compound allegedly synthesized by Jeon would have been expected to have the same utility as structurally similar compounds known in the art is inadequate to prove that hypothesis. Specifically, in the compounds disclosed in the Gluchowski patent the imidazolinylamino moiety is linked to a benzoxazine nucleus, a nitrogen- and oxygen-containing heterocyclic ring system. In the compounds

embraced by the count, the imidazolinylamino moiety is linked to a benzimidazole ring, a nitrogen-containing ring system. There is no evidence which establishes that a person of ordinary skill in the art would have considered a benzimidazole ring and a benzoxazine ring to be structurally similar. In In re Grabiak, 769 F.2d 729, 731, 732, 226 USPQ 870, 872 (Fed. Cir. 1985) the court held an expectation of similar utility for structurally similar compounds only arose after presentation of evidence of structural similarity and similar biological properties. See also In re Payne, 606 F.2d 303, 313, 314, 203 USPQ 245, 254, 255 (CCPA 1979); In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); In re Wilder, 563 F.2d 457, 465, 195 USPQ 426, 429 (CCPA 1977). As the court held in In re Payne at 606 F.2d 313, 203 USPQ 254:

"An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." [citations omitted]

Because there is no evidence which establishes at a time prior to Cupps et al.'s effective filing date that Jeon et al.'s compound would have been considered to be structurally similar

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to the compounds in Gluchowski, no expectation of properties similar to the properties for Gluchowski's compounds may be presumed. The same criticism applies to the compounds described in the van Meel et al. publication.



**CUPPS ET AL. REQUEST FOR SANCTIONS**

On page 6 of Paper Number 6, Cupps et al. has advised this Board that Jeon et al. failed to serve on the senior party a copy of any of the evidence which Jeon et al. submitted to establish their right to proceed under 37 C.F.R § 1.608(b). As correctly noted by Cupps et al., 37 C.F.R § 1.617(b), last sentence and 37 C.F.R § 1.612(c) require that such evidence be served on all opponents. While Cupps et al. have not specifically requested that we sanction Jeon et al. for their conduct, they parenthetically refer to 37 C.F.R. § 1.616(a) in the last sentence of the full paragraph on page 6 of Paper Number 6.

While we agree with Cupps et al. that Jeon et al.'s failure to comply with the rules is sanctionable conduct, Cupps et al. have not informed this Board what would be a suitable sanction for such conduct. Because we have ruled against the interests of the junior party Jeon et al. on all issues raised before us and because the senior party has not advised us as to what they would consider to be a suitable sanction, we decline to exercise our discretionary authority under the rules and sanction the junior party. Compare

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Gerritsen v. Shirai, 979 F.2d 1524, 24 USPQ2d 1912 (Fed. Cir. 1992).

**JUDGMENT**

In light of all the above, in accordance with 37 C.F.R. § 1.617(g), summary judgment with respect to Count 1 in this interference is awarded to Thomas L. Cupps and Sophie V. Bogdan, the senior party. Thomas L. Cupps and Sophie V. Bogdan, the senior party, are entitled to their patent containing claims 1 through 21 corresponding to Count 1. Yoon T. Jeon and Charles Gluchowski, the junior party, are not entitled to a patent containing claim 29 of their involved application corresponding to Count 1.

MARC L. CAROFF	)	
Administrative Patent Judge)	)	
	)	
	)	
ANDREW H. METZ	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
	)	
ADRIENE LEPIANE HANLON	)	

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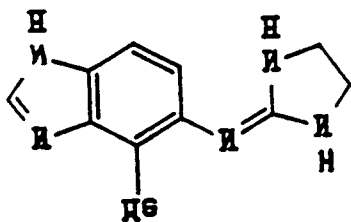
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APPENDIX

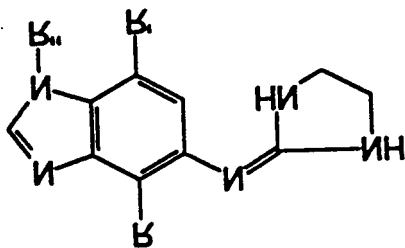
Count 1

A compound having the structure of Formula I:



-OR-

A compound having the following structure of Formula Ia:



wherein a) R is an unsubstituted alkanyl or alkenyl having from 1 to about 3 carbon atoms; b) R' is selected from the group consisting of hydrogen; unsubstituted alkanyl or alkenyl having from 1 to about 3 carbon atoms; unsubstituted alkylthio or alkoxy having from 1 to about 3 carbon atoms; hydroxy; thiol; cyano; and halo; c) R" is selected from the group consisting of hydrogen, methyl, ethyl and i-propyl;

-OR-

A pharmaceutical composition comprising a) a safe and effective amount of a compound of Formula I or Formula Ia, and b) a pharmaceutically acceptable carrier,

-OR-

A method for preventing or treating glaucoma, diarrhea or nasal congestion comprising administering a safe and effective amount of a compound of Formula I or Formula Ia to a subject in need of such treatment.

The claims of the parties which correspond to count 1 are:

Jeon et al.: 29

Cupps et al.: 1-21